



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,270	01/04/2002	Ping Zhou	784CIP2BDV1	6432

7590

06/17/2003

Luisa Bigornia  
HYSEQ, INC.  
670 Almanor Avenue  
Sunnyvale, CA 94085

EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/137,270

Applicant(s)

KAPLAN, KEVIN MARSHALL

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1 through Group 1103.

Claims 1-9, 19, drawn to polynucleotides, vectors and host cells comprising the same and a method of making the polypeptide, classified in class 435, subclass 69.1, wherein each group is directed to a single specific polynucleotide sequence, i.e., Group 1 through 877 is directed to Polynucleotide with SEQ ID NO:1 through SEQ ID NO:877 and Group 878 through Group 1103 is directed to Polynucleotides with SEQ ID NO: 879 through 1104.

Group 1104 through Group 2206. Claims 10-11, 20 drawn to polypeptides, classified in class 435/436, subclass 183., wherein each group is directed to a single specific polypeptide encoded by a single specific polynucleotide with SEQ ID NO:1 to 877 and 879 through 1104.

Group 2207. Claim 12, drawn to antibody directed to any one of the polypeptide encoded by polynucleotides with SEQ ID NO:1 through 877, 879-1104, classified in class 530, subclass 387.1.

Group 2208. Claims 13-15, drawn to a method of detecting a single polynucleotide elected from SEQ ID NO:1 through 877, 879-1104, classified in class 435, subclass 6.

Group 2209. Claim 16, drawn to a method of detecting a single elected polypeptide encoded by a single polynucleotide elected from SEQ ID NO:1 through 877, 879-1104, classified in class 435, subclass 4.

Group 2210. Claim 17-18, drawn to a method of identifying a compound that binds to a single elected polypeptide encoded by a single polynucleotide elected from SEQ ID NO:1 through 877, 879-1104, classified in class 514, subclass 789.

Group 2211. Claim 21, drawn to an array of polypeptide, classified in class 530, subclass 300.

Group 2212. Claims 22-25, drawn to a nucleic acid array, classified in class 435, subclass 287.2.

Group 2213. Claim 26, drawn to a computer medium, classified in class 712, subclass 1.

Group 2214. Claim 27, drawn to a method of treatment using a single elected polypeptide polypeptide, classified in class 424, subclass 94.1.

Group 2215. Claim 28, drawn to a method of treatment using an antibody raised against a single polypeptide, classified in class 424, subclass 130.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1 through 2207, 2211, 2212, 2213 are all products patentably distinct from each other. The polypeptides of groups 1104 through Group 2206, the polynucleotides of groups 1 through 1103, and the antibody raised against each polypeptide of group II each comprise amino acid sequences and nucleotide sequences which are chemically unrelated, do not require

each other for practice; have separate utilities, and are subject to separate manufacture and sale.

The groups have acquired separate status in the art and separate fields of search.

Inventions 1 through 1103 and 2208 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide can be used for making a recombinant protein as opposed to its use in the method of group 2208.

Inventions 1104 through 2206 and 2209, 2210, 2214 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide can be used for raising specific antibody as opposed to its use in the method of group 2209, 2210, 2214.

Inventions 2207 and 2215 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case the antibody can be used for affinity purification of a polypeptide as opposed to its use in the method of group 2215.

Inventions 2208, 2209, 2210, 2214 and 2215 are patentably distinct from each other. These groups are all directed to methods that are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group 1 is not required for any other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

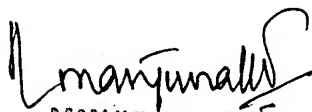
Art Unit: 1652

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
MANJUNATH RAO  
PATENT EXAMINER

Manjunath N. Rao  
June 13, 2003